

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 09/884,467 Confirmation No.: 9623  
Appellant : Jeffrey A. Bedell  
Filed : June 20, 2001  
Title : System and Method for Analyzing Statistics in a Reporting System  
TC/Art Unit : 2167  
Examiner: : Luke S. WASSUM  
Docket No. : 53470.003030  
Customer No. : **21967**  
**Mail Stop: Appeal Brief--Patents**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REPLY BRIEF**

**REPLY BRIEF**

In response to the Examiner's Answer mailed February 20, 2008, rejecting pending claims 1-29 and objecting to claim 30, Appellants respectfully submits the following reply brief.

**I. Status Of Claims**

Appellants note with appreciation the withdrawal of the rejection of claim 28 under 35 U.S.C. 112, first paragraph on page 7 of the Examiner's Answer. However, on page 4, Appellants note claim 28 stands rejected under 35 U.S.C. 112, first paragraph as allegedly failing to comply with the written description requirement. Because the Office acknowledged on page 7 the Appellants' arguments, withdrew the rejection, and did not provide further argument, Appellants assume that the rejection is withdrawn and will not address it further. However, Appellants note that claim 28 was not listed in any other rejections or objections and is not listed as allowed. Appellants respectfully request further clarification of the status of claim 28.

Claims 1-8, 10-17, 19-26 and 29 stand rejected under 35 U.S.C. 102(a) as allegedly being anticipated by IBM ("The Business Intelligence Infrastructure on S/390 Accessing DB2 on OS/390") ("IBM") as evidenced by Hahn et al. ("Capacity Planning for Business Intelligence Applications: Approaches and Methodologies") ("Hahn") and IBM[1] ("OS/390 Resource Measurement Facility Report Analysis") ("IBM1").

Claims 9, 18, and 27 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over IBM as evidenced by Hahn and IBM1, in further view of U.S. Patent Application Publication 2002/0046204 to Hayes ("Hayes").

Claim 30 is objected to as being dependent upon a rejected base claim.

The final rejection of claims 1-29 under 35 U.S.C. §§ 112, 102(a) and 103(a) is appealed.

## **II. Grounds Of Rejection To Be Reviewed On Appeal**

The following grounds of rejection are to be reviewed on appeal:

- The rejection of claim 28 under 35 U.S.C. 112, first paragraph as allegedly failing to comply with the written description requirement.<sup>1</sup>
- The rejection of claims 1-8, 10-17, 19-26 and 29 under 35 U.S.C. 102(a) as allegedly being anticipated by IBM (“The Business Intelligence Infrastructure on S/390 Accessing DB2 on OS/390”) (“IBM”) as evidenced by Hahn et al. (“Capacity Planning for Business Intelligence Applications: Approaches and Methodologies”) (“Hahn”) and IBM[1] (“OS/390 Resource Measurement Facility Report Analysis”) (“IBM1”).

---

<sup>1</sup> Appellants have listed the rejection of claim 28 under 35 U.S.C. 112, first paragraph as a ground of rejection to be reviewed upon appeal because it was listed in the Examiner’s Answer on page 4 as a rejection applicable to appealed claim 28. However, because the same rejection is withdrawn on page 7 and because further argument was not provided by the Office, the Appellants will not address the rejection further in this Reply Brief. Appellants respectfully request clarification from the Office regarding the status of claim 28. In the event the Office finds claim 28 allowable, an indication of such would be greatly appreciated. In the event a rejection is applicable to claim 28, Appellants reserve the right to address such a rejection.

- The rejection of claims 9, 18, and 27 under 35 U.S.C. 103(a) as allegedly being unpatentable over IBM as evidenced by Hahn and IBM1, in further view of U.S. Patent Application Publication 2002/0046204 to Hayes (“Hayes”).

### III. Argument

The Office has failed to show: (1) that the claims are anticipated and (2) that the claims are obvious.

#### A. The Rejection of Claims 1-8, 10-17, 19-26 and 29 Under 35 U.S.C. § 102(a)

Claims 1-8, 10-17, 19-26 and 29 are rejected under 35 U.S.C. 102(a) as allegedly being anticipated by IBM (“The Business Intelligence Infrastructure on S/390 Accessing DB2 on OS/390”) (“IBM”) as evidenced by Hahn et al. (“Capacity Planning for Business Intelligence Applications: Approaches and Methodologies”) (“Hahn”) and IBM[1] (“OS/390 Resource Measurement Facility Report Analysis”) (“IBM1”).

The independent claims 1, 10 and 19 recite “gather[ing] at least one statistic or data related to the performance operation of the reporting system while the reporting system is operating.” Appellants note the Office’s rejection continues to overlook the significance of the limitation “gather[ing] at least one statistic or data **related to the performance operation of the reporting system while the reporting system is operating.**” Appellants respectfully submit the rejection of claims 1-8, 10-17, 19-26 and 29 are rejected under 35 U.S.C. 102(a) is improper for at least the following reasons.

#### 1. The References Relied Upon by the Office Fail to Disclose a Connection Between Operating System Statistics and a Reporting System

The reference relied upon by the Office under 35 U.S.C. 102(a) fails to disclose any connection between an operating system gathering statistics and a reporting system that could

enable the statistics gathering process to determine whether the statistics are related to reporting system performance. Thus Hahn and/or IBM1 would record statistics regardless of whether they were related to a reporting system and regardless of whether a reporting system were even installed. At best, the alleged system of Hahn and/or IBM1 would leave it as exercise to the user to determine whether a reporting system was operating while the statistics were gathered and whether the statistics were related to the reporting system while the reporting system was operating. The mere fact that the disclosure mentions a business intelligence system and the gathering of statistics related to an operating system does not disclose the gathering of a statistic “related to the performance operation of the reporting system.”

2. An Operating System Statistic Indicating Performance Does Not Disclose An Operating System Statistic Related to Reporting System Performance

While the Office dismisses Appellants’ second argument as having merit but being nevertheless irrelevant, Appellants submit the converse of the argument is also true. *See* Examiner’s Answer, page 12. Specifically, while it is true that a reporting system may be experiencing poor performance and its underlying operating system may be performing well, it is also true that an underlying operating system may be experiencing difficulties and the difficulties may not be related to and/or affect a reporting system on top of the operating system. This is particularly true of an operating system, such as OS/390, which is well suited to run on a large complex system which may contain redundant and/or independent resources and hardware. For example, an operating system may control multiple storage devices, processors, processes, and/or peripheral devices. As an example, Hahn illustrates that any alleged statistics gathered may refer to one of many processors. Hahn recites the “CPU Activity Report provides an overview of activity for all processors belonging to this OS/390 image.” *See* Hahn, pg 66,

section 5.1.2. *See* also IBM[1], Chapter 5, page 5-9, Figure 5-2, (Illustrating multiple applications utilizing a single volume through a single UCB (Unit Control Block), and IBM[1], Chapter 5, page 5-28, Figure 5-17, (labeled “Activity of Top 10 Volumes”). The references provided by the Office clearly illustrate that OS/390 is an operating system capable of handling multiple resources and multiple applications utilizing different resources. Thus the references relied on by the Office illustrate a point known to a person of ordinary skill in the art. A hardware component or a process monitored by an operating system may encounter poor performance and it may not affect a reporting system relying on the operating system, at least because the reporting system may utilize other resources monitored by that instance of the operating system. Appellants submit that assumptions to the contrary overlook the significance of the phrase **“related to the performance operation of the reporting system.”** There is no disclosure that the statistics gathered at the operating system of the Office’s references will have any relation on the performance operation of the reporting system. A volume may fail and the reporting system may not be utilizing that volume, thus the performance of the reporting system may be unaffected. Any statistics related to the failure of such a volume would not be related to the performance operation of the reporting system. Thus the references relied upon by the Office fails to disclose each and every limitation of the pending claims.

Moreover, since the references relied on by the Office fail to disclose “gather[ing] at least one statistic or data related to the performance operation of the reporting system,” they certainly fail to disclose gathering such statistics or data “while the reporting system is operating.” The Office has failed to demonstrate that the statistics are related to the performance operation of the reporting system as discussed above. Further relating the statistics to a period in which a reporting system is operating is also not disclosed by the relied upon references.

3. The Examiner's Answer Clearly Misinterprets the Claims

Claim 1 recites “capturing at least one statistic or data regarding performance operation of a business intelligence reporting system that generates business intelligence reports **based on requests submitted to perform analysis of data.**” The Office incorrectly assumes that the element “based on requests submitted to perform analysis of data” does not refer to the “capturing [of] at least one statistic or data” despite the focus of the entire claim. The Examiner's Answer at page 14 states “the phrase ‘based on requests submitted to perform analysis of data in a database’ instead refers to the user requests to generate business intelligence reports.” See Examiner's Answer, page 14. Appellants respectfully disagree.

The Office asserts that “the correct interpretation is that the statistics gathered are based upon user requests to perform analysis of the business intelligence data in the system.” See Examiner's Answer, page 14. The Office asserts that “requiring a user to request ‘analysis of data’ before any statistics and/or data regarding performance operation of a business intelligence reporting system is captured ... cannot be the correct interpretation of the claims.” See *Id.* In contrast, the logical interpretation is that once the request is received, the data is gathered and then analyzed. Such an interpretation comports with the order of the claim elements, related disclosures in the specification and dependent claim 4. The first element of the method of claim 1 is “gathering at least one statistic or data ...” The second element is then analyzing the data which is contained in a database after it is gathered. The Office ignores the plain meaning of the claim to focus on historical activity because of the lack of disclosure in the references for the element ““capturing at least one statistic or data regarding performance operation of a business intelligence reporting system that generates business intelligence reports **based on requests submitted to perform analysis of data.**” The Office cites the Appellants' specification to

allege that the claims are directed towards analyzing historical data. Appellants respond that the specification also provides support for another embodiment not based on historical report system activity, such as the embodiment cited above and recited in the instant application at page 12, lines 13-16:

According to an embodiment of the invention, **statistics may be gathered in real-time**, thereby enabling an end user to analyze the reporting system in real-time or near real-time. Statistics reports may be generated in real-time or near real-time and then updated as new statistics are received, thereby providing a snapshot of the reporting system.

(page 12, lines 13-16, emphasis added)

Additionally, claim 4 illustrates that the Appellants contemplated embodiments not limited to those which would require data to be stored prior to receiving a user request. The method of Claim 4 enables the user to analyze the reporting system in real-time. If the method relied only upon data which had been stored in a database prior to a user request it would not enable a user to analyze a reporting system in real-time.

In contrast, the system management facility reports of Hahn relied upon by the Office, appear to be run as a default part of the operating system. “The OS/390 operating system includes the Systems Management Facility (SMF), which helps you measure various aspects of work running in the system.” IBM, page 65, section 5.1.1. A process run as a default part of the operating system does not teach or disclose “capturing at least one statistic or data regarding performance operation of a business intelligence reporting system that generates business intelligence reports **based on requests submitted to perform analysis of data.**” IBM, at most, suggests the default continual running of SMF processes to analyze data. A process which runs automatically as part of the operating system to capture data **is not** a teaching or suggestion of “capturing at least one statistic or data regarding performance operation of a business



intelligence reporting system” which is based upon “requests submitted to perform analysis of data.” A process running as an O/S default process is not run in response to a request to perform analysis.

As stated in MPEP § 2131, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Accordingly, for at least the above reasons, the Appellants respectfully request the reversal of the rejection of claims 1-8, 10-17, 19-26 and 29 under 35 U.S.C. 102(a).

**B. Rejection of Claims 9, 18, and 27 Under 35 U.S.C. § 103(a)**

Claims 9, 18, and 27 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over IBM as evidenced by Hahn and IBM1, in further view of U.S. Patent Application Publication 2002/0046204 to Hayes (“Hayes”).

The Examiner’s Answer admits that “the rejection of record does not allege that teaches [performing automated tuning of the reporting system based on the at least one output].” *See* Examiner’s Answer, page 17. The Office instead relies upon the previously addressed references. Thus, Hayes is not alleged by the Office to cure the above identified deficiencies of IBM[1], IBM[2] and Hahn, nor does it do so.

Furthermore, the Office again makes a critical mistake in interpreting the claims to not include the limitations inherent in claims 9, 18 and 27 by virtual of their dependency on the independent claims. Specifically, the tuning recited in claims 9, 18 and 27 is “based upon an output” which is based on data gathered based on requests submitted to perform analysis of data. The incorrect assumption of the Office is clearly recited as “the capturing of statistics cannot be

properly interpreted as occurring only in response to a user request to perform analysis of those same statistics, since were this to be the case, there would be no statistics to analyze.” *See* Examiner’s Answer, page 22. Appellants addressed this assumption above. As is clear from the specification as well as the elements of the claim, it is possible to gather statistics after receiving the request and then to analyze the statistics after gathering them.

Hayes fails to cure the deficiencies identified in the primary references. Thus, the Office has failed to provide a teaching or suggestion of every claim limitation.

As stated in MPEP § 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Accordingly, for at least the above reasons, the Appellants respectfully request the withdrawal of the rejection of claims 9, 18, and 27 under 35 U.S.C. 103(a).

**IV. Conclusion**

Because the cited reference fails to disclose or render obvious all features set forth in the pending claims, Appellants submit that the pending claims are allowable over the cited reference. Accordingly, Appellants respectfully request that the Board reverse the prior art rejections set forth in the Action, and allow all of the pending claims. Authorization is hereby granted to charge or credit the undersigned's Deposit Account No. 50-0206 for any fees or overpayments related to the entry of this Appeal.

Respectfully submitted,

Date: Apr 15, 2008

By: Bm  
Brian M. Buroker  
Registration No. 39,125

Hunton & Williams  
1900 K. St., NW, Suite 1200  
Washington, D.C. 20006-1109  
(202) 955-1894